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| 10/521,566   | 01/18/2005  | William Holm                | 0104-0499PUS1       | 9005             |
| 2292 7590 01/08/2009<br>BIRCH STEWART KOLASCH & BIRCH<br>PO BOX 747<br>FALLS CHURCH, VA 22040-0747 |             |                             |                     |                  |
| EXAMINER<br>HORNING, JOEL G  |             |                             |                     |                  |
| ART UNIT<br>1792   |             | PAPER NUMBER                |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/521,566

**Applicant(s)**

HOLM ET AL.

**Examiner**

JOEL G. HORNING

**Art Unit**

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 October 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.  
4a) Of the above claim(s) 26-37 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-25 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/CDC)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. **Claims 26-37** are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10-08-2008. The traversal was not convincing in view of the new restriction rationale.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The common technical feature that the groups share is a system for feeding a controlled amount of viscous material into a nozzle space and impacting the viscous material in order to jet droplets of the viscous material through a jetting nozzle. This common technical feature is not a special technical feature because La et al (US 5320250) teaches such a system (col 2, line 45 to col 3, line 5).

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "reduced" in claim 11 is a relative term which renders the claim indefinite. The term "reduced" is not defined by the claim, and the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in

the art would not be reasonably apprised of the scope of the invention. It is not clear what reduction of excess flow constitutes it being moved "reduced". Therefore, one would not know what the metes and bounds of the claims are.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-2, 4-7, 9, 10, 12 and 19** are rejected under 35 U.S.C. 102(b) as being anticipated by La et al US 5320250.

The instant claims are directed towards a method of jetting droplets of a viscous medium onto a substrate comprising of: Providing a nozzle, feeding a controlled amount of viscous medium into a nozzle space (*which is an adjustment of the volume of viscous material in the nozzle space*), and impacting said viscous medium thereby jetting the medium towards the substrate, *wherein the amount of viscous medium fed into the nozzle space has some dependence on the specific volume of each droplet to be ejected.*

La et al teach a method of jetting drops of viscous material onto a substrate wherein:

A first embodiment of our apparatus includes a reservoir that holds a predetermined volume of a viscous material. A chamber communicates with the reservoir for continuously receiving the viscous material therefrom. The chamber has a flexible resilient diaphragm which forms an exterior wall thereof. An impact mechanism, which may comprise a

solenoid actuated hammer, applies a predetermined momentum to the diaphragm to propel a predetermined minute quantity of the viscous material from the chamber through a nozzle at a high velocity. This minute quantity takes the form of a very small jet of fluid. As the impact energy is removed by means of a stop, the sudden decrease of the chamber pressure and the forward momentum of the jet "pinches" the jet to form a droplet, or blob... The diaphragm may be made of a synthetic material or it may be made of a thin metal sheet. In the latter case, a resilient compressible bumper such as an O-ring is provided under the metal sheet to rapidly restore the original configuration of the sheet after being struck by the hammer. The reservoir is preferably pressurized with gas to force the viscous material into the chamber for the purpose of refilling the chamber. Dispensing rates in excess of four blobs per second can be achieved. (col 2, line 45 to col 3, line 3)

The desired specific volume of the droplet is dependent on the volume of viscous material previously fed into the chamber. At the very least, enough material must be added to the nozzle space so that there is at least the desired specific volume of the viscous material present in the nozzle space in order to be ejected as the drop (**claim 1**).

**Per claim 2**, dictionary.com defines "corresponding" as "associated in a working or other relationship." If the amount entering is greater than the amount leaving, the device will rupture. If the opposite is true, then the chamber will empty and be unable to jet. Thus, the amount of filling in the described embodiment must be dependent on the volume of the droplet, so they are also associated. Since the size of the droplet is predetermined the amount of filling must be as well. Claim 2 is inherent to the teaching of La et al.

**Per claim 4**, see figures 3-5, the taught filling opening is on the opposite side from the nozzle, next to the diaphragm(which forms a wall of the chamber), and when the diaphragm configuration is restored the increase in chamber volume will result in the

portion of the nozzle space closest to the outlet being free of viscous material. This can be seen clearly in figure 9 of the second embodiment.

**Per claim 5-7**, La teaches a method that includes jetting multiple droplets. After a droplet is jetted, the diaphragm returns to its original position, which as stated for claim 4 reduces the volume of viscous medium in the nozzle space. Furthermore, the anvil requires some time to return to a start position (idle position) and strike again (a pause). La teaches that during this time the chamber is refilled to what is, as discussed previously, a preset degree.

**Per claims 9, 10 and 12**, for material to be jetted it must first be fed into the chamber, this is accomplished in the La et al process by activating a feeder (pressurizing it), which must occur at some predetermined time and would result in some predetermined pressure that would be required before the material would flow into the chamber. These claims are inherent to the La et al process.

**Per claim 19**, however controlled (i.e. feeding time or feeding rate) the feeder operation must be controlled to supply the necessary volume of material into the chamber; it is an inherent feature of La et al.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. **Claims 3, 8, 11, 13, 14, 20, and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over La et al as applied in the 102(b) rejection above.

**Claims 3, 11, 13, 14, 20 and 21** require controlling the filling rate, pressure or duration in order to fill the chamber with an appropriate volume of viscous material so that jetting can occur at some desired rate. As stated above, La et al teach controlling the pressure in order to refill the chamber with the desired volume, and pressure is a well known result effective variable for determining the rate of fluid flow and thus the duration of the refilling process required to reach that desired volume. It would have

been obvious to a person of ordinary skill at the time of invention that the pressure of the filling step well known user controllable process variables and to adjust them to produce the desired filling rate, duration and volume of viscous material in the chamber prior to jetting for different jetting sequences (**claims 3, 13, 14, 20 and 21**).

Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of invention to control the feeding operation (including its duration) such that no viscous material is fed into the nozzle space beyond what is required to refill it, such a person would be motivated to do so in order to avoid wasting the viscous material and thus reduce the material costs during operation (**claim 11**).

**Claim 8** requires moving the impact hammer into the idle position in such a way that no unintentional jetting of the viscous medium is produced.

La et al teaches that the spring bias is a result effective variable for controlling the impact hammer's return velocity (col 6, lines 48-53).

It would have also been obvious to a person of ordinary skill in the art at the time of invention to produce "no unintentional jetting of the viscous medium" through routine optimization of the spring bias, since that person would have been motivated to minimize the viscous material losses in order to increase the yield of jetted drops, since it has been held that when the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).



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4. **Claims 15-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over La et al as applied to claim 1 and 5 above, and further in view of Tzeng et al US 5988526.

The instant claims are directed towards the use of a vacuum to produce gas across the nozzle outlet in order to remove residual viscous material from the nozzle outlet.

La et al teach a jetting device for viscous material and that clogging of the device is a concern(col 2, lines 30-32) , but do not teach the use of a vacuum device to clean the nozzle.

However, Tzeng et al teach a "nozzle that has a vacuum hood which delivers a vacuum to remove residue from the nozzle and exterior of the nozzle" (col 1, lines 14-16). Further teaching doing so in order to reduce the chance of clogging the nozzle outlet (col 1, lines 24-25) as well as to reduce the chance of dripping the residue onto the substrate (col 2, lines 14-15).

It would have been obvious to a person of ordinary skill in the art at the time of invention to use the vacuum hood of Tzeng et al with the nozzle of La et al. That person would have been motivated to do so to reduce the chance of clogging the nozzle outlet as well as to reduce the chance of dripping the residue onto the substrate.

5. **Claim 22** is rejected under 35 U.S.C. 103(a) as being unpatentable over La et al as applied to claim 1 above, and further in view of Berg et al US6450416.

The instant claim is directed to a jetting device with a feed screw being used to feed the viscous medium.

La teaches such a jetting device, but silent about a feed screw as the feeding mechanism (*supra*).

However, Berg et al teaches the use of a feed screw on a device for jetting viscous materials in order to obtain improved control of the feeding rate (col 2, lines 24-40). It would have been obvious to a person of ordinary skill in the art at the time of invention to use the feed screw of Berg et al with the method of La et al in order to obtain improved control of the feeding rate.

6. **Claims 23-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over La et al as applied in the 102(b) rejection above as evidenced by LaBudde et al (US 6589791).

The claims further require controlling the (hammer) impact velocity of the device to produce predetermined and controllable exit velocities for the drops, regardless of size. Specifically, applicant claims the use of higher impact velocities for smaller drops and lower impact velocities for larger drops.

La et al teach the use of a solenoid actuated hammer wherein "an impact mechanism, which may comprise a solenoid actuated hammer, applies a predetermined momentum to the diaphragm for rapidly metering a predetermined minute blob of the viscous material from the chamber through the nozzle"(abstract). The depth of the hammer impact is controlled independently from the solenoid, so the impact velocity is an independent variable controlled by the solenoid energizing signal (col 5, lines 28-42).

It would have been obvious to a person of ordinary skill at the time of invention that these are known user controllable process variables and to adjust them to produce

the desired volume of viscous material in the chamber prior to jetting for different jetting sequences. Furthermore, splashing is undesirable for a controlled area deposition process (it reduces the accuracy of the deposition location. It is well known to the art of fluid flow that fluids will splash if they impact a surface at too high of a velocity(see supporting document enclosed in PTO-892 LaBudde et al. US 6589791, when to control their microfluidic dispersing system they teach that if the nozzle velocity of the drops is too high, splashing may result (col 25, lines 1-45)).

It would have been obvious to a person of ordinary skill at the time of invention that these are known user controllable process variables and to adjust them to produce a desired exit velocity, including increasing the impact velocity for small drops and reducing it for large drops in order to limit the exit velocity to a level that would avoid splashing.

One would be motivated to make such modification in order to run the process at as fast a rate as possible without reducing the accuracy of the targeting of the drops.

7. **Claims 1-7, 9, 10, 12-14, 19-21** are also rejected under 35 U.S.C. 103(a) as being unpatentable over La et al as applied above in view of Py (US RE37047).

Incorporating in totality the rejection of claim 1 above, La et al is directed to a method of metering individual droplets of a liquid onto a substrate with accurate control of the very small droplets' volumes through a nozzle and onto a substrate(abs) by controlling the depth of the hammer impact to the chamber that contains the viscous material (col 5, lines 40-42), and ejecting the drops at high rates (col 5, lines 43-44), but

does not teach controlling the volume of the droplets by changing the volume of the chamber.

Py also teaches a method for metering individual drops of material onto a substrate by actuating a hammer (piston-like) mechanism (abs), they teach these drops are small and require accurate control over the volume of the individual droplets (col 2, lines 25-28). In the Py process, first the fluid from a reservoir [133] is pressurized so that the fluid flows into and completely fills the volume of the nozzle space [154]. Then the hammer [116] is forced by the spring [158] against the fluid in the nozzle space, completely ejecting the fluid from the nozzle [120]. The process is repeated for multiple droplets (col 5, line 62 to col 6, line 26). The difference between La et al and Py is that Py teaches that the hammer stroke substantially evacuates the fluid from the nozzle space. The advantage of this kind of control mechanism is that the volume of the droplet is substantially predetermined by the volume of the nozzle space and thus can be controlled by controlling the nozzle space volume (col 6, lines 27-32). Py further teaches that this allows for the same volume to be reliably dispensed regardless of the speed of the hammer stroke (col 6, lines 50-58).

Thus it would have been obvious to a person of ordinary skill in the art at the time of invention to use modify the La et al method by controlling the volume of the nozzle space and having the hammer substantially evacuate it in order to have accurate control of the small drops' volumes regardless of the hammer velocity (**claims 1 and 2**).

**Claims 3-7, 9, 10, 12-14, 19-21** are now rejected for the same reasons they were in the 102(b) and the 103(a) rejections, but now in view of Py.

8. **Claims 15-18** are also rejected under 35 U.S.C. 103(a) as being unpatentable over La et al in view of Py as applied to claim 1 above further in view of Tzeng et al US 5988526.

These claims are rejected for the same reasons they were previously, but now in view of Py.

9. **Claim 22** is also rejected under 35 U.S.C. 103(a) as being unpatentable over La et al in view of Py as applied to claim 1 above further in view of Berg et al US6450416

This claim is rejected for the same reasons it was previously, but now in view of Py.

10. **Claims 23-25** are also rejected under 35 U.S.C. 103(a) as being unpatentable over La et al in view of Py as applied to claim 1 above further in view of LaBudde et al (US 6589791).

The claims further require controlling the (hammer) impact velocity of the device to produce predetermined and controllable exit velocities for the drops, regardless of size. Specifically, applicant claims the use of higher impact velocities for smaller drops and lower impact velocities for larger drops.

La et al teach the use of a solenoid actuated hammer wherein "an impact mechanism, which may comprise a solenoid actuated hammer, applies a predetermined momentum to the diaphragm for rapidly metering a predetermined minute blob of the viscous material from the chamber through the nozzle"(abstract). The depth of the hammer impact is controlled independently from the solenoid, so the impact velocity is an independent variable controlled by the solenoid energizing signal (col 5, lines 28-42).

Furthermore, splashing is undesirable for a controlled area deposition process (it reduces the accuracy of the deposition location. It is well known to the art of fluid flow that fluids will splash if they impact a surface at too high of a velocity (see LaBudde et al, when to control their microfluidic dispersing system they teach that if the nozzle velocity of the drops is too high, splashing may result (col 25, lines 1-45)).

It would have been obvious to a person of ordinary skill at the time of invention that these are known user controllable process variables and to adjust them to produce a desired exit velocity, including increasing the impact velocity for small drops and reducing it for large drops in order to limit the exit velocity to a level that would avoid splashing.

One would be motivated to make such modification in order to run the process at as fast a rate as possible without reducing the accuracy of the targeting of the drops.

### ***Response to Arguments***

11. Applicant's arguments, with respect to the 112 2<sup>nd</sup> rejections of claims 8, 11 and 20 have been fully considered and are persuasive in view of the amended claims 8 and 11 and that the term "substantially" as used is considered definite. Thus the 112 2<sup>nd</sup> rejection of claims 8, 11 and 20 has been withdrawn.

12. Applicant's arguments with respect to claims 1-25 have been considered but are not convincing due to the new rejection necessitated by amendment.

### ***Conclusion***

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13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

/Michael Cleveland/

Supervisory Patent Examiner, Art Unit 1792